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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,381	09/10/2003	Kiyoshi Miyake	S0529.0006	3331
32172	7590	11/02/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,381

Applicant(s)

MIYAKE, KIYOSHI

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The abstract of the disclosure is objected to because it amounts to a general statement as to what is known in the prior art and thus does not adequately or sufficiently apprise the reader of any inventive aspect described in the disclosure. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 16 and 25 are objected to because of the following informalities: as to claim 16, "gripping" in line 8 should be --gripped--; as to claim 25, second occurrence (first occurrence in line 7) of "a distal portion" line 9 should be --proximal portion--; claim 25, last line, "so as to display panel side" should be --so as to open to a display panel side--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 17 recites that the proximal open end opens "between the grip portion and the frame of the

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display portion". Although the specification mentions that the open end opens on the frame and on the grip portion, since there is no clear line of demarcation between the frame and grip portion (note that most embodiments appear to include an integral, one-piece housing defining the frame and grip portion), it is unclear as to what position is "between" the frame and grip portion.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 21, "a base of a grip end of the grip portion" is vague and indefinite. A grip *end*, although broad, is understandable. What is not understandable is what part of the grip end is the *base*.

As to claim 25, "display portion" (line 17) lacks antecedent basis.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 16-19 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossoff (U.S. Pat. 5,183,031).

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Rossoff discloses a flexible slender insertion section comprising a slender flexible tube (proximal end of 12) which inherently has a proximal and distal portions, a bendable portion (distal end of 12) and a distal portion (18), an operation section coupled to the insertion section and having a grip portion (24), a bending operation portion (22) and a display portion formed of a display panel (30) which displays the observation image, the display panel provided on a frame (the inherent structure surrounding the optics of the optical head and including the focusing ring 34) integrally attached to the grip portion (note stem 32, Fig.1). The insertion section has a channel (16) which opens at the distal end and has a proximal open end formed by a port (44,46) (forceps-port constructing member) opening to a rear side of the display panel (note Figs. 1 and 3). This port is located "near" any part of the device and is not disclosed as interfering with any part of the device. As to claim 17, the proximal opening of the channel can be considered to be "between" the grip portion and the frame. As to claim 21, considering the top portion (portion including port 44) as the "base of a grip end" of the grip portion, the proximal opening is provided on such.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 15, 17-23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabover et al. (U.S. Pat. 5,785,644) in view of Salvati et al. (U.S. Pat. 5,373,317) and

further in view of Ebling et al. (U.S. Pat. 4,934,340) for the reasons set forth in numbered paragraph 13 of the previous Office Action, paper number 05112005.

It is noted that claims 15, 17-23, 25 and 26 recite substantially similar features of the previously rejected claims 1-11 and 14. However, as to claim 17, Figure 1 of Grabover et al. clearly shows that the proximal opening is "between" the display panel and grip portion, as broadly as claimed (although it is not clear what this means with respect to Applicant's invention). In addition, as to claim 21, the end of the grip portion proximate to housing (50) can be considered a "base of a grip end" as broadly as claimed. As to claim 26, as broadly as claimed, the "tube supporting member" is nothing more than the proximal end of the tube which forms the claimed channel. Note that the proximal end of the channels disclosed by Grabover et al. which extend which are enclosed by the housing (50) and connect to ports (62,66,68) (note col.7, lines 46-48) would be considered to be "between" the frame and the proximal position of the flexible tube portion.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grabover et al. in view of Salvati et al. and further in view of Ebling et al. and further in view of Green (U.S. Pat. 5,928,137)

Grabover et al., as modified above, appears to disclose a display panel that is not detachable (detachability would inherently require a connection portion). Green evidences that a detachable display panel has been contemplated in the prior art. Because of the level of ordinary skill and the known advantages of making something "detachable", it would have been obvious to one of ordinary skill in the art to have made the display panel of Grabover et al. detachable.

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Motivation would stem from logic and ordinary skill: replacement of a defective display would be made easier, cleaning and sterilizing would be made easier, and such detachability would increase the versatility by allowing for upgrades.

12. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grabover et al. in view of Salvati et al. and further in view of Ebling et al. and further in view of Ciarlei (U.S. Pat. 5,314,070)

Grabover et al., as modified above, fails to disclose a case for housing the device in a wound state. Ciarlei teaches a case (11) for housing an endoscope in a wound state to "provide a simple and reliable storage and transport case structure" (col.1, lines 57-60). It would have been obvious to one of ordinary skill in the art to have provided a case as claimed for the endoscope of Grabover et al. for the reasons taught by Ciarlei.

Response to Arguments

13. Applicant's arguments filed August 17, 2005 have been fully considered but they are not persuasive.

It is noted that new claims 15-27 recite substantially the same features as previous claims 1-14, with slight clarifying language for certain features. The claims are addressed above. Since Applicant's arguments do not address the merits of the previous positions/rejections taken with respect to the cited prior art references, no comments from the Examiner are warranted.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

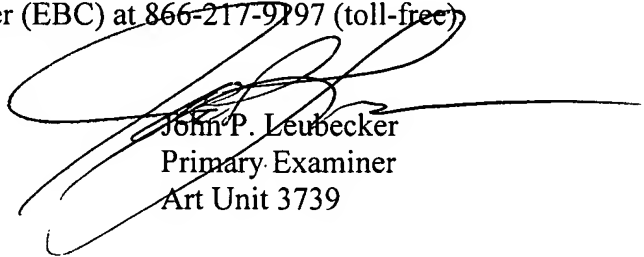
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl